



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,034	01/20/2004	Anette Israelsson	AAB-1 Cont.	3924

1473 7590 09/07/2005

FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
1251 AVENUE OF THE AMERICAS FL C3  
NEW YORK, NY 10020-1105

EXAMINER

KIDWELL, MICHELE M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/762,034

Applicant(s)

ISRAELSSON ET AL.

Examiner

Michele Kidwell

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 37-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-62 is/are allowed.
- 6) ☐ Claim(s) 63-74, 83-101, 113-115 is/are rejected.
- 7) ☒ Claim(s) 75-82 and 102-112 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63 – 64, 67 – 74, 83 – 89, 92 – 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod (GB 2,284,764), and further in view of Shepherd (US 3,566,874).

As to claim 63, McLeod discloses a wetting apparatus comprising a catheter package (figure 1) comprising a sealed elongated volume having at least one chamber that surrounds at least a portion of the insertable length of a urinary catheter (4), wherein the chamber comprises a first chamber comprising a wetting fluid container having wetting fluid therein, said wetting fluid container opening upon application of a predetermined condition to enable the wetting fluid to discharge to wet at least a tip portion of the insertable length of the catheter (page 2, paragraph 6 to page 6, paragraph 6) and the first chamber is defined by a restriction in the elongated volume (9) as set forth in figure 1.

The difference between McLeod and claim 1 is the provision that the catheter is hydrophilic.

Art Unit: 3761

Shepherd teaches a hydrophilic catheter as set forth in col. 1, lines 8 – 60.

It would have been obvious to one of ordinary skill in the art to employ a hydrophilic catheter in the invention of McLeod because a hydrophilic catheter would reduce the irritation and infection normally accompanying the use of a hydrophobic catheter as taught by Shepherd in the abstract.

As to claims 64, 89 and 99, see McLeod, page 3, paragraph 4.

As to claims 67 and 92, McLeod discloses the wetting fluid to be fully contained within the wetting apparatus as set forth on page 6, paragraph 6.

With reference to claims 68 – 69, 71, 73, 93 – 94, 97 the applicant has stated on page 11 of the specification that the container may be constructed to move freely about. Therefore, it has been suggested that permanently fixing or having the wetting fluid container be integrally formed within the receptacle would provide no unexpected results to the function of the apparatus and would be an obvious matter of design choice.

As to claim 70, see McLeod, page 3, paragraph 4.

With respect to claim 72, see McLeod, page 3, paragraph 4 and page 6, paragraphs 5 – 6.

With respect to claim 74, see McLeod, page 3, paragraph 4.

With reference to claim 83 – 85 and 113 – 115, McLeod discloses a wetting apparatus meeting all of the limitations of the claims as set forth on page 13.

As to claims 86 – 88, see the rejection of claims 63 and 68 – 69.

As to claims 95, 96 and 98, see the rejection of claim 63. The area of weakness is 9.

With reference to claim 1193, McLeod discloses the wetting fluid container in the form of a sachet as set forth on page 6, paragraph 6.

Claims 65 – 66, 90 – 91 and 100 – 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod in view of Shepherd, and further in view of Gordon et al (US 3,967,728).

The difference between McLeod in view of Shepherd and claim 65 is the provision that the wetting fluid container is made of aluminum foil, poly(vinylidene chloride) or a metallicized film.

Gordon et al. (hereinafter "Gordon") teaches a wetting fluid container comprised of aluminum foil, poly(vinylidene chloride) or a metallicized film as shown in figure 6.

It would have been obvious to one of ordinary skill in the art to further modify the wetting fluid container of McLeod to employ aluminum foil, poly(vinylidene chloride) or a metallicized film because these materials would protect the integrity of the lubricant since sterilizing gases, such as ethylene oxide, may have a deleterious effect upon the lubricant as taught by Gordon in col. 3, lines 45 – 52.

With reference to claims 66, 91 and 101, Gordon teaches the use of a metallicized film as set forth in col. 4, lines 31 – 42.

Additionally, absent of critical teaching and/or show of unexpected results derived from the use of metallicized film, the examiner contends that the use of

Art Unit: 3761

metallicized film would have been an obvious matter of design choice which does not patentably distinguish the claimed invention from the prior art invention.

Regarding claims 90 and 100, see the rejection of claim 65.

***Allowable Subject Matter***

Claims 37 – 62 are allowed.


Claims 75 – 82 and 102 – 112 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday - Friday, 5:30am - 2:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michele Kidwell  
Primary Examiner  
Art Unit 3761